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EXAMINER

NGUYEN, JIMMY H

ART UNIT

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 09/932,213	Applicant(s) WEBB ET AL.	
	Examiner JIMMY H. NGUYEN	Art Unit 2629	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 October 2010.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 19-21,24-26,45-48 and 50 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 19-21,24-26,45-48 and 50 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 25 October 2010 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>10/28/2010</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This Office Action is made in response to applicant's amendment filed on 10/25/2010. Claims 19-21, 24-26, 45-48 and 50 are currently pending in the application. An action follows below:

Information Disclosure Statement

2. The information disclosure statement (IDS) submitted on 10/28/2010 is being considered.

Drawings

3. The drawings submitted on 10/25/2010 are **NOT** accepted by the Examiner because new figures 18-19 introduce new matter. The original disclosure does not explicitly disclose at least the buttons "1" and "2" disposed on the bottom of the digitizer, the buttons "3" and "4" disposed on top of the digitizer, and the buttons "1" to "4" and the digitizer disposed on the right side of the display screen 126, as shown in Figures 18-19. For the above reason, figures 18-19 are NOT accepted by the examiner.

Specification

4. The amendment filed 10/25/2010 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: figures 18-19 are NOT accepted by the examiner. Applicant is required to cancel the new matter in the reply to this Office Action.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it

Art Unit: 2629

pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. Claims 47-48 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

As to claim 47, this claim contains the limitation, “wherein the multi-directional mechanism includes a set of one or more buttons” including “**wherein the multi-directional mechanism includes a set of one button**”, which was not described in the original disclosure at the time the application was filed. The original disclosure, specifically the specification, page 9, last line to page 10, line 2, discloses a multi-directional component 134 formed from plural buttons, plural contact-sensitive surfaces, or other mechanical switches. Accordingly, this claim contains the above underlined limitation, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

As to claim 48, this claim recites the limitation, “wherein **one or more** of the input mechanisms from the set of **one or more** input mechanisms...mechanical input mechanisms”, which includes “wherein **two, three, or four** of the input mechanisms from the set of **one** input mechanism”, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Further, examiner can’t understand how two or more input mechanisms are from a set of **ONLY** one input mechanism. Accordingly, this claim contains the

Art Unit: 2629

above underlined limitation, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

8. Claims 19-21 and 24-26 are rejected under 35 U.S.C. 102(e) as being anticipated by Susel (US 6,111,527).

As to claim 19, Susel discloses a mobile device (see Fig. 2) comprising

a first segment (a lower compartment 112 having a touch sensitive display disposed thereon; Fig. 2; col. 7, lines 45 to col. 8, line 3);

a display assembly (a touch sensitive display disposed in the lower compartment 112; Fig. 2; col. 7, lines 45 to col. 8, line 3) accessible on a front surface of the first segment (Fig. 2); and

a second segment (120, 122; Fig. 2) slideably coupled to the first segment (112) to move between a contracted position (best seen in Fig. 1A) and an extended position (Fig. 2), wherein an overall width of the mobile device is (i) maximized when the second segment is in the extended position (Fig. 2), and (ii) minimized when the second segment is in the contracted position (Fig. 1A),

Art Unit: 2629

wherein the overall width of the mobile device is reduced when the second segment is moved towards the contracted position (Fig. 1A) from the extended position (Fig. 2) so that when the second segment is in the contracted position, at least a portion of the second segment overlays and is external to the first segment (Figs. 1A, 2); and

a set of one or more input mechanisms (keys of keyboard; Fig. 2) provided on the second segment (120, 122) so as to be exposed when the second segment is in the extended position and when in the contracted position (Fig. 2).

Accordingly, all features of this claim are read in the Susel reference.

As to claim 20, Susel discloses the display assembly being contact-sensitive (Fig. 2; col. 7, line 45 to col. 8, line 3).

As to claim 21, Susel discloses all of the display assembly is accessible to receive contact as input when the second segment is in the extended position (Fig. 2).

As to claim 24, Susel discloses a midframe (38, 40; best seen in Fig. 1E) coupled to a first housing segment (12/112) and a second housing segment (20, 22/ 120, 122).

As to claims 25-26, Susel discloses the midframe (38, 40) including a first rail (38) and a second rail (40), and wherein the second segment (20, 22) includes a first connecting member (134, 142; Fig. 2) and a second connecting member (136, 144; Fig. 2), the first connecting member (134, 142) being engaged to the first rail (38), the second connecting member (136, 144) being engaged to the second rail (40), the first connecting member and the second connecting member each moving a distance in the respective first rail and second rail to enable the second segment to move between the contracted position (Fig. 1A) and the extended position (Fig. 2).

Art Unit: 2629

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 45-48 and 50 are rejected under 35 U.S.C. 103(a) as being unpatentable over Susel, and further in view of Kulp (US 4,803,474).

As to claim 45, see the rejection to claim 19 above for similar features. Susel further discloses the set of one or more input mechanisms (keys of the keyboard) including a multi-directional mechanism (arrow keys; Fig. 2) having a plurality of actuation states including one or more directional actuation states. Susel does not disclose the multi-directional mechanism including a center actuation state corresponding to a central contact of the multi-directional mechanism and is silent to the multi-directional mechanism being operable to enable the user to enter selection input, including input for selection of displayed data corresponding to any one or more of a menu item, a data entry, or an application being displayed on the display assembly.

Accordingly, the Susel reference discloses all limitations of this claim except for the multi-directional mechanism including a center actuation state corresponding to a central contact of the multi-directional mechanism and the multi-directional mechanism being operable to enable the user to enter selection input, including input for selection of displayed data corresponding to any one or more of a menu item, a data entry, or an application being displayed on the display, of this claim.

Art Unit: 2629

However, Kulp discloses a keyboard comprising the set of one or more input mechanisms including a multi-directional mechanism having a plurality of actuation states, including one or more directional actuation states and a center actuation state corresponding to a central contact of the multi-directional mechanism, wherein the multi-directional mechanism is operable to enable the user to enter selection input, including input for selection of displayed data corresponding to any one or more of a menu item, a data entry, or an application being displayed on the display assembly (Figs. 3-4; col. 3, lines 53-62; col. 4, lines 21-32). It would have been obvious to a person of ordinary skill in the art at the time of the invention was made to replace the multi-directional mechanism of Susel with the multi-directional mechanism of the Kulp reference, in view of the teaching in the Kulp reference, because this would the operator quickly, easily and intuitively select any one of several specially-marked and pre-programmed action points, as taught by the Kulp reference (col. 2, lines 18-25).

As to claim 46, Susel teaches the display assembly being contact-sensitive (Fig. 2; col. 7, line 45 to col. 8, line 3).

As to claim 47, Kulp teaches the multi-directional mechanism including a set of 9 buttons (Fig. 3; col. 3, lines 53-62).

As to claim 48, Susel in view of Kulp discloses the first input mechanism including a plurality of one or more mechanical input mechanisms (see Fig. 2 of the Susel reference).

As to claim 50, Susel teaches the second segment (120, 122) configured to slide towards and away from the first segment (112) (Figs. 1A, 2).

Response to Arguments

Art Unit: 2629

11. Applicant's arguments filed 10/25/2010 have been fully considered but they are not fully persuasive because as follows:

With respect to the drawing objections in the Office Action dated 06/25/2010, the objections are withdrawn in light of the amendment to claims 19 and 45. However, Examiner disapproves the new Figures 18-19. See the above drawing section. Examiner suggests the applicant not to submit any new figures in order to avoid an introduction of new matter.

With respect to the specification objection in the Office Action dated 06/25/2010, the objection is maintained because Figs. 18-19 are not approved by the Examiner.

With respect to the rejections under 35 USC 112, first paragraph, as failing to comply with the written description requirement to claims 19-21, 24-26 and 45-50 in the Office Action dated 06/25/2010, Applicant's arguments (see pages 8-11 of the amendment), have been fully considered and they are persuasive in light of the amendment to claims except for claims 47 and 48. See the above rejection.

With respect to the rejections under 35 USC 112, first paragraph, as failing to comply with the enablement requirement to claims 19-21, 24-26 and 45-50 in the Office Action dated 06/25/2010, Applicant's arguments (see pages 11-12 of the amendment), have been fully considered and they are persuasive in light of the amendment to claims. These rejections are withdrawn.

Conclusion

12. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

Art Unit: 2629

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jimmy H. Nguyen whose telephone number is 571-272-7675. The examiner can normally be reached on Monday - Friday, 6:30 a.m. - 3:00 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bipin Shalwala can be reached at 571-272-7681. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Jimmy H Nguyen/

Primary Examiner, Art Unit 2629